

Bristol, Lynn Anne (AU1643)

From: Bristol, Lynn Anne (AU1643)
Sent: Monday, December 07, 2009 12:07 PM
To: Witz, Jean
Subject: RE: question re: priority claim for USAN 10/570,010

boy, what an answer. Thank you sooooo much, Jean!!

From: Witz, Jean
Sent: Monday, December 07, 2009 7:44 AM
To: Bristol, Lynn Anne (AU1643)
Subject: FW: question re: priority claim for USAN 10/570,010

here you go!

From: Wolski, Susan
Sent: Friday, December 04, 2009 12:14 PM
To: Witz, Jean
Subject: RE: question re: priority claim for USAN 10/570,010

Just a clarification of a few things. In a 371 application, priority is NOT claimed to the international application. The national stage is the continuation of the prosecution of the international application. The oath correctly indicates that the specification being sworn to was filed on August 26, 2004 as application PCT/US2004/027954. The oath is filled out properly, with no indication of any priority claim to the international application.

The published international application claims priority to the provisional application 60/498,260 (you can view the 1st page of the publication under doc code ABST) and the priority claim is properly indicated also in the 1st sentence of the SPEC. PALM has only picked up this priority to the provisional application.

The only reference I can find to 09/996,069 (although I must admit that I did not meticulously view every document in the application) is in the supplemental box of the Request of PCT/US04/027954, which indicates that the international application is a continuation-in-part of 09/996,069. Therefore, I am confused by the statement below that indicates that the international application claims priority to the '069 application. The international application cannot claim priority to any application filed more than a year before the international filing date. IF applicant wanted to claim priority to the '069 application, they need that reference in the international application, but they must also make a priority claim in the national stage application in either the first sentence of the specification, or on an application data sheet. I do not see any ADS in the application, and there is no claim to priority to the '069 application in the first sentence of the SPEC that I can find. Therefore, in this national stage application, there is no claim to priority to the '069 application (unless I have missed something in my haste). That means that the only priority date is to the provisional, filed in 2003, which would be the date for the purpose of prior art.

I just glanced briefly at applicant's remarks concerning priority. They indicate that this application is a national stage of PCT/US05/32821, which claims priority to 09/996,069. They are confused. This application is the national stage of PCT/US04/27954, and while the publication of this application indicates that the international application is related to 09/996,069, it does not claim priority to it, and if they want a priority claim in a national application, they must make the claim in that national application as I have indicated above, either in the 1st sentence of the SPEC or in an ADS. The PALM record does not indicate that claim, and neither does the published application. At this point, the application is after final. Applicant would have to file a big bucks petition, and the examiner would have to enter the priority claim (which, I would think, would not be likely at this point). Looks like applicant would have to file another RCE together with the petition to enter the priority claim.

Let me know if you have any questions, or if I've missed something.

Sue

The 371 national-stage entry application (10/570,010) claims priority to a) international PCT/US04/027954 in its Oath/Dec, and b) U.S. provisional 60/498,260 in its cross-reference section in the spec. The '010 application does not claim priority to USAN 09/996,069 per se.

The international PCT/US04/027954 claims priority to U.S. provisional 60/498,260 (2003 filing date) and USAN 09/996,069 (2002 filing date). USAN 09/996,069 is pending.

What is the effective priority date for my application 10/570,010 for purposes of applying art : the provisional or the 09 case?

Jean